



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,067	08/20/2001	Steve Brandstetter	P/94-1	6703

7590 07/31/2009
Philip M. Weiss, Esq.
Weiss & Weiss
Suite 251
300 Old Country Road
Mineola, NY 11501

EXAMINER

COBURN, CORBETT B

ART UNIT	PAPER NUMBER
----------	--------------

3714

MAIL DATE	DELIVERY MODE
-----------	---------------

07/31/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/933,067	Applicant(s) BRANDSTETTER ET AL.	
	Examiner Corbett B. Coburn	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-13, 16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-13, 16 & 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3714

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-9, 11-13, 16 & 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation concerning counting coins between players is not supported in the specification. There is no evidence that Applicant had possession of the claimed invention at the time of filing.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-9, 11-13, 16 & 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. “Said numeric device continuing to count from player to player...” does not specify what is being counted. Examiner presumes coins but as written, it could be counting players.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3714

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6, 9, 12, & 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okuniewicz (US Patent Number 6,585,589) in view of Quinn (US Patent Number 3,688,276).

Claim 1: Okuniewicz teaches device for paying out a bonus (Col 1, 43-46) to a player playing a gaming machine. (Fig 1) There is a gaming machine (Slot Machine). The gaming machine obviously contains a processor for implementing a game of chance (including video poker) and paying off according to matching symbols. (Col 1, 20) There is a dispensing unit (Lottery Terminal). Since Okuniewicz teaches that the dispensing unit may dispense a ticket when a preset amount of coins are inserted (Col 3, 46-53), there must be a numeric counter for counting the number of coins placed in said gaming machine that counts coins until a ticket is generated. Okuniewicz does not teach visually displaying to the player the number of coins needed to generate a ticket or the number of coins inserted by the player. Nor does Okuniewicz teach resetting the counted coins to zero once a ticket is generated. These are common functions on virtually any modern vending machine.

Quinn, which is also a lottery ticket dispenser, teaches visually displaying to the player the number of coins needed to generate a ticket and the number of coins inserted by the player as well as resetting the counted coins to zero once a ticket is generated. (Fig 1) Such a visible meter allows the player to know how much money he must insert and how much money he has inserted. Clearing the counter lets the player know that if he wants another ticket, he has to put in more money. These features add to user

Art Unit: 3714

convenience and are, as previously pointed out, extremely well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Okuniewicz in view of Quinn to visually display to the player the number of coins needed to generate a ticket and the number of coins inserted by the player as well as to reset the counted coins to zero once a ticket is generated in order to add to player convenience.

Furthermore, a combination of prior art elements, each performing their normal functions in a predictable manner to yield a predictable result is obvious. In this case, Okuniewicz teaches a slot machine that dispenses a lottery ticket when a preset number of coins have been inserted into the machine. Quinn, which also dispenses a lottery ticket when a preset number of coins have been inserted into the machine, has a meter that displays the number of coins inserted and the number of coins remaining prior to dispensing a ticket. In the combination, Okuniewicz's slot machine/ticket dispenser works in its accustomed manner. Quinn's lottery ticket dispenser/coin meter work in its accustomed manner. The combination of Okuniewicz and Quinn yield predictable results. The combination is therefore obvious.

Regarding the ticket being supplemental to a gaming award, see the underlined portion of the rejection above. Regarding the numeric counter continuing to count (presumably coins) from player to player until the dispensing unit dispenses a ticket, Okuniewicz has no mechanism for determining who deposits a coin. Neither does Quinn. Clearly, since neither device can determine when one player leaves & another player arrives, the numeric counters in both would continue to count coins until a ticket is

Art Unit: 3714

dispensed.

Claims 2-4: Okuniewicz teaches that the dispensing unit may be a retrofit unit for a slot machine (Col 3, 1-4). Okuniewicz teaches that the dispensing unit could be attached to the gaming machine externally (i.e., side-mounted) or mounted internally. (Col 4, 63-66)

Claim 5: The gaming machine may include video poker machines (Col 3, 36-42). Video bingo games and video keno games are disclosed as equivalents.

Claim 6: The dispensing unit is a self-contained unit that does not affect play or outcome of said gaming machine. (Col 4, 35-43)

Claim 9: Okuniewicz dispenses lottery tickets. (Abstract)

Claim 12: Claim 12 is a combination of claims 1, 5, & 9 with the addition of holding a drawing to determine a winner of said ticket – which is taught by Okuniewicz.

Claim 16: Okuniewicz teaches the lottery ticket may be for the Big Game. In the Big Game, a bonus prize is generated from a percentage of total coins placed into all participating gaming machines (i.e., a percentage of money used to buy game tickets).

8. Claims 7, 8, 11, 13 & 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okuniewicz and Quinn as applied to claim 1, 12 above, and further in view of Castellano et al. (US Patent Number 5,477,952).

Claims 7, 13: Okuniewicz and Quinn teach the invention substantially as claimed. Both contain coin counters, but do not give details of the operation thereof. Okuniewicz bonuses a player based on number of coins played (Col 3, 51) but does not teach that the numeric counter counts coin pulses off of the gaming machine's hard meter. Castellano teaches the method of operation of the coin counters. Castellano teaches that the numeric

Art Unit: 3714

counter (12) counts coin pulses off of the gaming machine's hard meter (52). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Okuniewicz and Quinn in view of Castellano to have the numeric counter count coin pulses off of the gaming machine's hard meter in order to carry out Okuniewicz and Quinn's suggestion to count the coins entered by the player.

Claim 8: Okuniewicz and Quinn teach the invention substantially as claimed. Neither specifically discloses that the numeric counter can count various coin denominations. Castellano specifically teaches discloses that the numeric counter can count various coin denominations. (Fig 1, 21-24) Allowing players to use more than one denomination makes it convenient for the player to put more money in the slot machine. This increases profits. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Okuniewicz and Quinn in view of Castellano to have the numeric counter can count various coin denominations in order to make it convenient for the player to put more money in the slot machine.

Claims 11, 18: Okuniewicz teaches that the benefit of the device is the ability to change the criteria for generating a ticket. (Col 3, 1-9) The LIB is a remote unit (i.e., a separate module) for changing the number of coins necessary to generate said ticket.

Response to Arguments

9. Examiner thanks the Applicant for clearing up the drawing issue.
10. Applicant's arguments are drawn to the claims as amended & are answered in the rejection above.

Art Unit: 3714

11. While Applicant has still failed to distinguish over the prior art of record, Examiner thinks this amendment represents a *bona fide* attempt to do so – even if the Applicant had to introduce new matter in order to make the amendment. Therefore, Examiner will not issue a final rejection in this action. Examiner urges Applicant to carefully read the references & see if there is anything that distinguishes over the combination.

12. Frankly, Examiner has read Applicant's specification & has wracked his brain for any non-obvious differences, but to no avail. Applicant's invention appears to be Okuniewicz with the addition of a display to show the number of coins counted. Even before the *KSR* decision, Examiner was forced to conclude that the Applicant's invention was obvious over the prior art. After *KSR*, it became even more difficult to allow such combinations of well-known elements.

13. While Examiner is not attempting to discourage Applicant from further prosecution, Examiner feels that he would be remiss if he did not point out any potentially patentable subject matter he has found in the Applicant's disclosure. Examiner would be equally remiss for failing to point out the complete absence of any such subject matter since that is, in his opinion, the case.

14. Of course, Applicant is more familiar than Examiner with the disclosure & may be aware of a feature Examiner has overlooked.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30.

Art Unit: 3714

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Corbett B. Coburn/
Primary Examiner
Art Unit 3714